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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,103	03/08/2001	Francis Guerit	14XZ00108	4918

7590 11/08/2002  
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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/802,103

Applicant(s)

GUERIT ET AL.

Examiner

Ryan M Flandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

### *Claim Objections*

3. Claims 1 and 2 are objected to because of the following informalities:
  - a. Claim 1. In lines 2-3 of the claim, the phrase "...the structural features having respective apertures comprising a flexible hollow element...", is confusing. It is unclear whether the flexible hollow element comprises a portion of the structural features or, in the alternative, the aforementioned device for joining (line 1). For purposes of

examination, the Examiner has read the limitation in light of the more general device.

Appropriate correction is required.

b. Claim 2. The recitation of “at least one of two ends of the element is joined to the corresponding structural features *in* at least two contiguous sides” at line 3 of the claim is not supported by the disclosure or in the drawings. For purposes of examination, the Examiner has read the limitation as “on” or “at”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1. Specifically, claim 1 recites the limitation "the covers" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim because no “covers” are previously recited. For purposes of examination, the Examiner has read this limitation as -the structural features-. Because claims 2-24 depend from claim 1, they are likewise rejected.

b. Claims 16 and 17. Both claims recite “a thickness.” It is unclear whether this thickness is the same or different from the thickness recited in claims 14 and 15, respectively.

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c. Claim 20. Claim 20 recites the limitation "the covers" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim because no "covers" are previously recited.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Groves et al (US 3,306,634) (Groves). Specifically, Groves discloses a device for joining at least two structural features **102, 110** having a relative mobility (see column 2 lines 5-15), the device enclosing or surrounding means for connecting **104** structural units **41, 5**, the structural features **102, 110** having respective apertures, comprising a flexible hollow element **118** that is shaped so as to enclose or surround the means for connecting **104** and having respective ends **119, 120** which are joined to the apertures of the [structural features] **102, 110** (see figures 1 and 2; column 2 lines 45-53).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groves, as applied in section 7 above.

a. Claim 2. Groves further discloses that the structural features **102, 110** are arranged at an angle to one another (see figure 2), and at least one of two ends **119, 120** of the element **118** is joined to the corresponding structural features **102, 110** [on] at least two contiguous sides of the structural feature **102, 110** (see figure 1; column 2 lines 45-53).

Nonetheless, Groves fails to disclose the structural features as generally parallelepipedal in shape. A change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the structural features of Groves by making them parallelepipedal in shape.

b. Claim 3. Grove discloses the claimed invention except for the structural features arranged at a right angle. It would have been obvious to one having ordinary skill in the art at the time the invention was made, however, to arrange the structural features of Groves at a right angle, since it has been held that rearranging the parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

c. Claims 4 and 5. Groves shows the element **118** in a sheath form (figure 1).

d. Claims 6 and 7. Grove discloses that the element **118** is made of an elastomeric material (see column 2 line 45) but fails to explicitly recite that the material is silicone. It have been obvious, however, to one having ordinary skill in the art at the time the invention was made to make the element out of silicone because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

e. Claims 8-10. Further, Grove discloses the claimed invention except for the elastomeric material having a shore hardness of 40 to 60. It have been obvious, however, to one having ordinary skill in the art at the time the invention was made to make the element of 40-to 60 shore hardness since it has been held that where the general

conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

f. Claims 11-13. Similarly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the element of 50 shore hardness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

g. Claims 14 and 15. Similar to the argument made in section (e) above, Grove discloses the claimed invention except for the elastomeric material having a thickness of between 2 and 5 mm. It have been obvious, however, to one having ordinary skill in the art at the time the invention was made to make the element of a thickness between 2 and 5 mm since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

h. Claims 16 and 17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the element of a thickness of 2.5mm since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

i. Claims 18 and 19. Grove further shows the two ends **119, 120** of the element **118** and margins of the apertures of the structural features **102, 110** having complimentary profiles (see figure 1).

j. Claims 21 and 22. Groves also shows the ends **119, 120** of the element **118** cemented at margins of the apertures of the structural features **102, 110** (figure 1; column 2 lines



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45-53). Examiner notes the broad definition of cement as "something that serves to bind or unite" (Webster's New World Dictionary, College Edition, ©1968 The World Publishing Co.).

k. Claims 22 and 23. Groves further discloses the respective ends 119, 120 of the element 118 fixed to the respective structural features 102, 110 (figure 1; column 2 lines 45-53).

l. Claim 24. Groves further discloses that the means for connecting **104** comprises a mechanical connection (see features **108, 109**) between the structural units **41, 5** (see figure 1; column 1 lines 60-64).

m. Claim 25 is rejected under the rationale set forth in section above, and subparagraphs (d) and (e) of this section.

n. Claim 26 is rejected under the rationale set forth in subparagraph (g) of this section.

o. Claim 27 is rejected under the rationale set forth in subparagraph (a) of this section.

p. Claim 28 is rejected under the rationale set forth in subparagraph (b) of this section.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 09/846,427. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite devices for joining at least two structural features having a relative mobility, the device covering connecting means and the features having respective apertures comprising a flexible element that is shaped so as to cover the means for connecting with end which are joined to the apertures of the covers. Although claim 3 of copending Application No. 09/846,427 does not explicitly disclose that said flexible element is hollow, this limitation is inherent in light of the fact that the element "covers" the connecting means and also because the element has "apertures opposite one another." This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to devices for joining structural elements:

U.S. Patent 6,022,047 to Okubo

U.S. Patent 5,147,695 to Colley et al.

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U.S. Patent 4,416,475 to Stacey

U.S. Patent 3,633,946 to Kazmierski, Jr.

U.S. Patent 3,663,044 to Contreras et al.

U.S. Patent 1,352,019 to Murphy

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952.

The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ryan M. Flandro  
November 4, 2002



**Lynne H. Browne**  
**Supervisory Patent Examiner**  
**Technology Center 3670**